UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,781	01/05/2001	Craig S. Skinner	PALM-3551.US.P	3204

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EXAMINER
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ART UNIT	PAPER NUMBER
2182	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	09/755,781	SKINNER, CRAIG S.
	Examiner	Art Unit	
	Alan S. Chen	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 February 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-11 and 13-24* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-11 and 13-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>10 October 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>12/27/2006</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to claims 1-4,6-11 and 13-24 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless —
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

3.   Claims 1-4,6-11,13-20,23 and 24 are rejected under 35 U.S.C. 102(e) as being

anticipated by US Pat. No. 6,564,056 to Fitzgerald.

4.   Per claim 15, Fitzgerald discloses a communication network device *(Fig. 1,*

elements 120-140 are all communication network devices on PDN network; PDA,

element 124, is a specific one of the network devices) configuration method *(Fig. 2*

shows the method) comprising the steps of: storing communication network

configuration information in a memory *(Fig. 3, information from the memory card is*

downloaded in the memory of Fig. 1, element 100; configuration information includes

manufacturer assigned device ID number and various communication programs for

interacting with devices 120-140); using said communication network configuration

information to automatically configure without user interference a communication device

for communicating with a communication network when booted up *(Column 9, lines 5+*

and discloses using configuration information to register the device with the hub,

element 100, which then enables communication internally to the PDN network as well

as externally on the Internet; no user intervention is required except for inserting the

memory card; note, the specification of the instant application requires an active step of

activating the system by the user, this is equivalent to the active step of inserting the

card per the reference) by forwarding a network unit device identifier *(Column 9, lines*

1+ discloses device ID is downloaded/forwarded from memory card to hub; Column 9,

lines 45-51 specifically discloses manufacturer registration information used to register

device with manufacture via the external network), the network unit device identifier

loaded by a manufacturer *(Column 4, lines 60-65 specifically discloses ID being*

manufacturer assigned); and activating said device automatically on communication

network *(Fig. 3, element 324, activates/registering the device with the manufacturer; all*

of activation steps in Fig. 3 is automatic once the memory card is inserted).

5.   Per claim 16, Fitzgerald discloses claim 15, Fitzgerald further disclosing said

network configuration information includes information for automated activation on a

communication network *(Fig. 3, all steps are automated once memory card is inserted,*

where the network configuration information on the memory card is used to activate the

device internally on the PDN as well as on the external network, e.g., with the device

manufacturer).

6.   Per claim 17, Fitzgerald discloses claim 15, Fitzgerald further disclosing the

network configuration information includes a network unit device identifier *(Fig. 3,*

"device ID").

7.   Per claim 18, Fitzgerald discloses claim 15, Fitzgerald further disclosing said

network configuration information is loaded by a manufacturer *(Column 4, lines 60-65,*

manufacturer assigns device ID).

8.   Per claim 19, Fitzgerald discloses claim 15, Fitzgerald further disclosing a

processor utilizes the communication network configuration information to automatically

configure the device for communication on a network *(Fig. 2, element 210)*.

9.   Per claim 20, Fitzgerald discloses claim 15, Fitzgerald further disclosing network

configuration information includes an access number *(Fig. 2, element 206 has a*

telephone interface, requiring an access number; Both the data network interface and

cellular interface, elements 204 and 210 also need an access number).

10.   Per claim 1, Fitzgerald discloses a communication network automated activation

system *(Fig. 1)* comprising a processor *(Fig. 2, element 210)* for processing information

and instructions including network configuration information *(Fig. 3 shows network*

registration and activation performed by hub processor) utilized by said processor to

automatically configure without user interference a device *(Fig. 1, element 124 is a PDA*

device) for communicating on a communication network with automated registration and

activation on said communication network when booted up *(Column 9, lines 5+ and*

discloses using configuration information to register the device with the hub, element

100, which then enables communication internally to the PDN network as well as

externally on the Internet; no user intervention is required except for inserting the

memory card; note, the specification of the instant application requires an active step of

activating the system by the user, this is equivalent to the active step of inserting the

card per the reference) by forwarding a network unit device identifier*(Column 9, lines 1+*

discloses device ID is downloaded/forwarded from memory card to hub; Column 9, lines

45-51 specifically discloses manufacturer registration information used to register

device with manufacture via the external network), the network unit device identifier

loaded by a manufacturer*(Column 4, lines 60-65 specifically discloses ID being*

manufacturer assigned); a network interface component *(Fig. 2, elements 204-208)* for

communicating information to and from other devices, said network interface

component coupled to said processor *(Fig. 2, elements 204-208)*; a memory for storing

said network configuration information *(Fig. 2, element 212)*; said memory is coupled to

said processor *(Fig. 2, element 212 is coupled to 210 via bus 216)*; and a data bus *(Fig.*

2, element 216) for communicating information between said processor and said

memory, said data bus coupled to said processor *(Fig. 2, element 216 the data bus is*

coupled to processor, element 210).

11.   Per claim 2, Fitzgerald discloses claim 1, Fitzgerald further disclosing said

network configuration information includes a network unit identifier *(Fig. 3, "device ID")*.

12.   Per claim 3, Fitzgerald discloses claim 2, Fitzgerald further disclosing said

processor forwards said communication network unit identifier to a communication

network when a network communication application is opened *(Column 2, lines 5-10,*

communications programs downloaded from memory card).

13.   Per claim 4, Fitzgerald discloses claim 2, Fitzgerald further disclosing said

network unit identifier is an access number *(Fig. 2, element 206 has a telephone*

interface, requiring an access number; Both the data network interface and cellular

interface, elements 204 and 210 also need an access number).

14.   Per claim 6, Fitzgerald discloses claim 1, Fitzgerald further disclosing said

processor communicates said network configuration information with said network and

receives network unit identification information from said network *(Fig. 3, elements 316-*

320 updates registration/activation information performed over network to device), said

processor utilizes said network unit identification information to configure said device for

communication on said communication network *(Fig. 3, device ID used in establishing*

communication over network).

15.   Per claim 7, Fitzgerald discloses claim 1, Fitzgerald further discloses said

network interface component *(Fig. 2, elements 204-208)* comprises: a transmitter for

generating radio signals for communicating information over a cellular communication

network *(Fig. 2, element 208)*; said transmitter coupled to said communication bus *(Fig.*

2, element 216); a receiver for accepting radio signals from said cellular communication

network, said receiver coupled to said communication bus *(Fig. 2, element 208 is a*

transceiver); and an antenna for transmitting and receiving radio signals to and from

said cellular communication network, said antenna coupled to said transmitter and said

receiver *(Fig. 2, element 208, antenna is inherently needed for wireless*

communications).

16.   Per claim 23, Fitzgerald discloses claim 1, Fitzgerald further discloses the

memory comprising read-only memory *(Fig. 2, element 212)*.

17.   Claims 8-11,13,14 and 24 are significantly similar to claims 1-4,6,7 and 23 and

therefore the rejections of claims 1-4,6,7 and 23 are applied accordingly.

Claim Rejections - 35 USC § 103

18.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

19.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating
       obviousness or nonobviousness.

20.   Claims 21 and 22 are rejected under 35 USC 103(a) as being unpatentable over

Fitzgerald in view of US Pat. No. 6,961,567 to Kuhn *(previously cited)*.

Fitzgerald discloses claims 1 and 8. Fitzgerald discloses use of PDA device,

which can have a handwriting recognition pad *(Fig. 1, element 124)*. Fitzgerald further

discloses inputting data other than network configuration information to interact with the

network *(Column 4, lines 50+)*.

Fitzgerald does not disclose expressly having a handwriting recognition pad that interacts with the processor by inputting data to the processor.

Kuhn discloses a PDA device with a handwriting recognition pad typical of the time of the invention of Fitzgerald *(Fig. 1, element 12)*.

Fitzgerald and Kuhn are analogous art because they are from the same field of endeavor in use of a PDA device.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the handwriting recognition pad to send user requested data over the network.

The suggestion/motivation for doing so would have been the pad is a convenient means for the user to input data particularly if the PDA does not have a keypad for the user to input his/her requests.

Conclusion

21.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

22.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Alan S. Chen whose telephone number is 571-272-

4143. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kim N. Huynh can be reached on 571-272-4147. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ASC
04/10/2007

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